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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,087	01/29/2002	Haruko Toyoshima	0445-0315P	2505

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EXAMINER
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REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/01/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/01/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/058,087	TOYOSHIMA, HARUKO	
	Examiner	Art Unit	
	Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-24-06 and 11-30-06 has been entered.

### ***Response to Amendment***

2. The following action is based on the amendments to the specification filed 11-30-06, the claims filed 11-30-06 including the 7-24-06 amendments thereto and the remarks filed 7-24-06 and 11-30-06.

### ***Specification***

3. The disclosure is objected to because of the following informalities: Applicants have amended claims 1, 4-5 and 8, see the underlined portions of the claims filed 7-24-06 and 11-10-06. In the remarks of the 7-24-06 and 11-30-06 responses certain portions of the original specification were referred to as providing support therefor. The limitations other than those discussed infra are considered clear and supported by the original application. With regard to the remaining additions, at the very least, it is unclear what structure is being described. For example, see lines 16-19 of claim 1 which set forth the under waist elastic members are fixedly

Art Unit: 3761

disposed in at least areas extending outwardly from the longer sides of the absorbent member in their stretched state while one of the sheets are expanded in a plane so as to manifest contractibility. However what plane is being referred to? Is Applicant trying to describe the expanded state of the diaper or something else? Part of the process by which the elastic members are being disposed, i.e. a stretch bonded laminate of some sort such as that set forth in the sentence bridging pages 7-8 of the specification. For another example, see lines 12-13 of claim 1 which set forth a pair of longer side portions of the diaper each being provided with a sheet forming an upright cuff and further containing leg elastic members. While the originally filed application describes a sheet 62 provided on each side portion of the diaper which contains elastic members 61 and the combination forms an upright cuff, i.e. the side portions of the diaper contain such elastic members 61, and also elastic members 9 contained within the side portions, it is unclear whether what is being claimed is the same, i.e. are the claimed sheet and elastic members the cuff 6? The sheet 62 and the members 9? In the latter case, how does the sheet form an upright cuff? Note also the reference to such elastic members in claim 4 and the discussion of that claim infra. For a third example, claims 4 and 8 now claim the under waist elastic members being disposed in a area that is nearer to a middle of a width direction of the diaper than the respective ends of a pair of elastic members located in a portion of the diaper having the fastening tapes. While the originally filed application describes the ends of elastic members 9 being at the respective side edges of the main body which edges are also provided with the tapes, it is not clear whether what is being claimed is the same. See also the discussion of claims 1 and 5, last paragraph, in paragraph 6 infra. Therefore, at the very least, a clear,

Art Unit: 3761

consistent description of the invention whose full scope is supported by the originally filed specification should be set forth throughout the application. Appropriate correction is required.

### ***Claim Objections***

4. Claims 1-2, and 4-8 are objected to because of the following informalities: in claim 1, line 18, “one” should be --an associated one--. This also applies to similar language on line 24 of claim 1. In claim 1, third to last line, “arranged in the width direction” is redundant. See the preceding terminology “oriented in the width direction”. “Arranged” as defined by the dictionary is “to put into a specific order or relation, dispose” and “orient” as defined by the dictionary is “to locate or place in a particular relation with respect to a reference”. Therefore “oriented in the width direction” and “arranged in the width direction” are considered to be the same and contrary to Applicant’s 11-30-06 remarks. It is noted that such claim language does not require no elastic members linearly oriented end to end perpendicular to the longitudinal centerline of the diaper, i.e. like the under waist elastic member 8. This also applies to similar terminology in claim 5. In claim 4, second to last line “a portion” should be --portions--. In claim 4, third to last line, “,” should be deleted. This also applies to similar language in claim 8. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 4, a positive structural antecedent basis for “said pair of leg elastic members” should be defined. Note claim 1 claims a pair of side portions with leg elastic members not a pair of leg elastic members.

6. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 5, last paragraphs, see also discussion in paragraph 4 supra, now claim “no elastic members oriented in a width direction being arranged in a width direction of said diaper” in a portion of the diaper extending between the crotch portion and the second waist opening portion. While the originally filed application shows no elastic members linearly oriented end to end perpendicular to the longitudinal centerline of the diaper, i.e. like the under waist elastic member 8 in the other end, this is not what is claimed. The original application also shows elastic members 9 collectively or elastic members 61 collectively or both collectively include elastic members oriented in a width direction/being arranged in a width direction in portion(s) of the diaper in which it is now claimed that there are no elastic members so oriented in and arranged in the width direction and/or each of the elastic members 9 having ends which are oriented in a width direction/being arranged in a width direction in portion(s) of the diaper in which it is now claimed that there are no elastic members so oriented in and arranged in the width direction. If Applicant maintains the claim language, the portion of the original specification providing support for the scope of such language in combination with the remainder of the invention as claimed in a single embodiment should be set forth.

***Claim Language Interpretation***

7. Claim 1 as best understood now requires the waist opening portion being provided with a continuous waist elastic member arranged in an extended state in a width direction of the diaper. It is still noted that claim 1 does not require the elastic members be stretched from a nonstretched state to a extended state and then fixed to the areas in the extended state and then released from such state allowing contraction to the nonstretched state. The fixing of a temporarily or permanently stretched material to the areas and the areas being able to contract due to the disposition of such stretched material only is required. It is further noted that the claims, as best understood, still do not require the under-waist portion positioned right below the waist opening portion and the areas extending outwardly from the absorbent be one and the same, i.e. coextensive, or the under-waist elastic members only being in the under-waist portion or being coextensive therewith. Finally it is noted that while the waist opening portion requires a continuous waist elastic member, such member is still not required to be continuous with the entire waist portion, i.e. the member is continuous in some portion of the waist opening portion (Note the original filed Figures show a continuous elastic member in each of the front and rear portions of the waist opening portion, but such member does not span the entire front or rear portion, i.e. does not extend side edge to side edge in such portions). Nor is the elastic member required to be provided in the portion of the waist opening portion which is right above the under waist portion or right above the elastic members thereof. These comments also apply to similar language in claims 5-8. (It is noted that the language of claim 1, i.e. "being positioned right below", and that of claim 5, i.e. "positioned directly below" appear to be the same as "right" as defined by the dictionary is "in direct line or course directly, straight" and "direct" is defined as

Art Unit: 3761

“to extend or project in a specified line or course”.) All the claims require the fastening tapes be directly attached to the under-waist portion. However this does not require that the tapes are directly attached to the elastic members thereof. Nor do the claims require the entire waist opening portion have an extension stress less than that or those of the entire under-waist portion. In addition, claim 1 at a minimum requires non-monolithically formed and not touching waist opening and under-waist elastic members in light of the amendments, elastic members in the areas outside the absorbent member but not where a portion thereof exists at a middle portion of the underwaist portion which are fixed in such areas so as to manifest contractibility in light of the lack of clarity discussed supra (Note MPEP 2113 with regard to lines 16-19 of claim 1 and similar language in claim 5, i.e. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process), and the under-waist portion having a greater extension stress than at least some portion of the waist opening portion. Additionally due to the lack of clarity discussed supra the longer side portions in claim 1 are considered to include at a minimum a sheet which is part of a cuff and elastic members, and in claims 4 and 8 the under waist elastic members are disposed in an area closer to the longitudinal centerline of the diaper than ends of leg elastic members located in portions of the diaper having the fastening tapes, e.g. the respective side portions of the diaper. With respect to the last paragraph of claims 1 and 5, also see MPEP 2163.06 (I).



*Claim Rejections - 35 USC § 102*

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-2, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Clear et al '584, and thereby Buell et al '274.

Claim 1: See Figure 2, i.e. topsheet 24, backsheet 22, core 28, fastening tapes 92, landing zone 44, waist opening portion is at least a portion of waist edge 64, waist elastic member 34, under-waist portion is at least a portion of 30 which portion includes at least a portion of elastic members 90 and which portion is additionally directly attached to at least a portion of tape 92. See also col. 14, lines 27-61, col. 15, line 16-col. 16, line 24 of Clear et al, and thus by incorporation Buell '274 at, e.g., col. 35, line 57-col. 36, line 30, especially col. 36, lines 2-5, i.e. the members 90 can be associated with the topsheet and backsheet in the tensioned condition, i.e. stretched state, col. 51, lines 3-64, esp. lines 56-64, Figure 1, col. 45, lines 23-30, col. 15, lines 16-27, col. 23, lines 13 et seq, col. 33, lines 51-53, col. 42, lines 44-52, col. 43, lines 14-38. It is also noted that 1N is about 150 gf. With regard to the limitations of claim 1 not already addressed supra, see Claim Language Interpretation section supra, the discussion of references supra and the discussion infra with respect to the remarks, i.e. '584 and '274 include at a minimum non-monolithically formed waist opening and under-waist elastic members, i.e. elements 34 and 90 which are separate and don't touch and also note col. 42, lines 44-42 of '274 again as well as col. 46, lines 13-31 of '274, the element 90 is arranged in an extended state, see the Claim Language Interpretation section supra and '274 at col. 36, lines 2-5, elastic members of the under-waist portion in the areas outside the absorbent member but not a portion thereof/the

Art Unit: 3761

middle area of the underwaist portion which are fixed in such areas so as to manifest contractibility, see portions of references cited supra, the under-waist portion having a greater extension stress than at least some portion of the waist opening portion which is at least indirectly connected to the tapes, see portions of references cited supra, and no elastic members oriented in a width direction being arranged in a width direction of said diaper in a portion of the diaper extending between the crotch portion 59 and the second waist opening portion adjacent 35.

Claim 2: See the first full paragraph of col. 16 of '584.

Claims 5-7: See the discussion of claims 1 and 2 supra.

***Claim Rejections - 35 USC § 102/103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 4 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Clear et al '582, and thereby Buell et al '274 and Lawson '278.

With regard to claims 4 and 8, see the discussion in paragraphs 3-5 and 7 supra and see the paragraph bridging cols. 13-14 of '584, and thereby by incorporation, '278 at, e.g., the Figures, especially Figure 3 and Figure 7, and col. 11, lines 45-51, and the Figures of '582, especially element 85 and 86. Therefore '582 is considered to teach or obviously teach the elastics disposed along an inwardly curved line, as best understood, because when the cuff elastics shown in the stretched state are allowed to contract, the diaper forms U-shape and the

Art Unit: 3761

elastics are disposed along such U-shape which is an inwardly curved line and teach the location of the elastic members, as best understood, because an elastic member 77 as taught '278 can be situated adjacent the attached end of the upstanding portion of the cuff, i.e. the edge of 85 laterally outwardly of 86 as shown by '584, whereby the ends thereof which are disposed in longitudinal side portions of the diaper which side portions are also provided with the fastening tapes are also disposed further outward relative to the middle of the width direction than the inwardmost lateral edge of 90. The prior art also teaches elastic members 152 which or obviously which are disposed along a curve and have ends which are located as claimed as best understood.

### ***Response to Arguments***

12. Applicant's remarks have been considered. With regard to the matters of form, such remarks are either considered moot in that they have not been reraised or are deemed not persuasive for the reasons set forth supra. See especially discussion in paragraphs 1-6 supra. The remarks with respect to the prior art on page 13-17 of the 7-24-06 response have been considered but since they are substantially the same as those set forth on pages 8 et seq of the 4-29-05 response such remarks are still considered not persuasive for the same reasons as set forth in paragraph 5 of the 6-04 Office Action (i.e. "As set forth in the rejection such elastic members are considered 34 and 90 and 34 can be provided at or on both of the end portions and in at least the central region and generally forms at least a portion of the waist edge and 90 is also provided in the rear waist portion in at least a portion of the ear 88, see, e.g. '274 at col. 34, lines 53-55, col. 35, lines 62-64, col. 42, lines 44-52 and col. 43, lines 14-42, i.e. both members are in the

Art Unit: 3761

portion which also has fastening tapes and at least a portion of the tapes are at least directly attached to at least a portion of the under-waist portion. Applicant's arguments with regard to the extension stress are still deemed not persuasive in light of Buell at, e.g., col. 45, lines 23-30 and incorporated by Clear which also teach the embodiment of the side panels having extension forces greater than those of the waistband, i.e. the extension force of 90 can be greater than that of 34. Note also the Claim Language Interpretation section supra. Finally, Applicant's arguments with regard to the untensioned condition are still deemed not persuasive in light of Buell at, e.g., col. 36, lines 2-5, and incorporated by Clear, i.e. the members 90 can be applied in a tensioned or stretched condition. In response to the arguments with regard to the extent of elastic member 90 bridging pages 13-14 of the remarks, such remarks are deemed narrower than the teachings of the prior art, i.e. see portions of references cited supra which do not only teach the member extending over the waist and under-waist portions, i.e. different embodiments. In response to Applicant's reiteration of the remarks filed 2-19-04, e.g. on pages 15 et seq, such remarks have been considered but are still deemed narrower than the teachings of the prior art. For example: 1) It is noted that the '584 incorporates all of the '274 disclosure, see col. 14, lines 47-52 of '584. 2) '584 at col. 14, lines 38-52, teaches a rear or second waist region having an elastic waist feature constructed as taught by '274 and 274 at col. 12, lines 24-27 teaches waist feature 34 can be in both end portions and at col. 12, lines 52-53 and 62-63 teaches such elastic waist features include elastic waistband 35. 3) 274' at col. 45, line 45-col. 46, line 31 teaches that the extension forces of the waist band can be greater than, equal to or lesser than those of the side panel and the side panel may have extensibility that varies longitudinally from the end edge to the leg edge, i.e. the portion of the side panel if adjacent the waist edge can have an extension

Art Unit: 3761

stress same as, lesser than or greater than the waist band and greater than or less than the remainder of that side panel between that portion and the leg edge, i.e. the remainder of the side panel or under waist portion is taught as having a greater extension stress than the waist opening portion”), especially in light of the new issues set forth supra, as well as the discussion of claims 1-2 and 4-8 supra with regard to the prior art.

### *Conclusion*


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Paragon Trade '813 reference as well as '301 reference incorporated thereby, also teach waist elastic members and under-waist elastic members. Also note page 7, lines 10-21 and Figure 6 of '813 which teach fastening tapes and show the waist elastic members being spaced further apart than the underwaist elastic members. Note also paragraph 56 of Yeager '065.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3761

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Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
February 15, 2007